

**Amendments to the Drawings:**

The attached sheets of drawings includes changes to Figs. 2A, 6, and 7.

The first replacement sheet, which includes Fig. 2A, replaces the original sheet including Fig. 2A.

In Figure 2A, previously omitted reference numeral 130 has been added.

The second replacement sheet, which includes Figs. 4 and 7, replaces the original sheet including Figs. 4 and 7. In Figure 7, previously numbered element 400 has been changed to element 700.

The third replacement sheet, which includes Figs. 6 and 8, replaces the original sheet including Figs. 6 and 8. In Figure 6, two of the three previously numbered elements 610 have been changed to element 620.

Attachments:      Replacement Sheet 1  
                          Replacement Sheet 2  
                          Replacement Sheet 3  
                          Annotated Sheet 1 Showing Changes  
                          Annotated Sheet 2 Showing Changes  
                          Annotated Sheet 3 Showing Changes

**REMARKS**

Claims 1-57 were originally filed in the present application. No claims are currently added or deleted. Accordingly, claims 1-57 remain pending in the present application.

Reconsideration of this application in light of the above amendments and the following remarks is requested.

**Objections to the Specification**

In the specification, the paragraphs [0024], [0029], [0036], and [0049] have been amended to correct minor editorial problems.

The Examiner objected to the disclosure because of the use of the term “e-line,” which the Examiner asserted was not understood by those of ordinary skill in the art and that no definition was provided. However, paragraph [0007] provides, in part, “Generally, e-lines employ a multi-functional wire to suspend a tool in a specific location in a well and to transmit power and/or data signals between the wellbore and the well surface.” It is believed that, upon review of paragraph [0007], the term “e-line” will be understood by those of ordinary skill in the art. Therefore, Applicants respectfully request the Examiner withdraw the objection.

**Objections to the Drawings**

The Examiner objected to the drawings because reference numeral 130 was inadvertently omitted. Consequently, reference numeral 130 is currently added to Fig. 2A by the present amendments. Accordingly, Applicants respectfully request the Examiner withdraw the objection to Fig. 2A.

The Examiner also objected to the drawings because apparatus which should have been identified by reference numeral 620 was incorrectly identified by reference numeral 610. Consequently, Fig. 6 is currently amended to correct this inadvertent error. Accordingly, Applicants respectfully request the Examiner withdraw the objection to Fig. 6.

The Examiner also objected to the drawings because apparatus which should have been identified by reference numeral 700 was incorrectly identified by reference numeral 400. Consequently, Fig. 7 is currently amended to correct this inadvertent error. Accordingly, Applicants respectfully request the Examiner withdraw the objection to Fig. 7.

The Examiner also objected to the drawings because the reference numeral 800 was allegedly

omitted. However, Fig. 8 on pg. 8 of the drawings includes reference numeral 800 in the top right portion of the drawing sheet. Accordingly, Applicants respectfully request the Examiner withdraw the objection to Fig. 8.

**Rejections under 35 U.S.C. §102(b)**

Claims 1, 2, 4, 7-10, 19-24, 27, 28, 30-33, 35-39, 41, 43, 44, 46, 47, 49-51, 53, 55 and 57 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,919,219 to Taylor (“Taylor”).

**Claim 1**

Claim 1 recites:

1. An impact jar, comprising:  
an impactor having a first down-hole tool connector;  
an impactee slidably coupled to the impactor, having a second down-hole tool connector distal from the first down-hole tool connector, and  
having a plurality of flexible coupling fingers positionally fixed relative to the second down-hole tool connector in an axial direction; and  
a biasable member detachably engaged by the plurality of flexible coupling fingers in a pre-impact position and configured to disengage the plurality of flexible coupling fingers in response to a tensile force applied across the first and second down-hole tool connectors reaching a predetermined quantity, wherein the impactor and impactee are configured to impact in response to the disengagement of the biasable member and the plurality of flexible coupling fingers.

The PTO provides in MPEP §2131 that

*“[t]o anticipate a claim, the reference must teach every element of the claim....”*

Therefore, to sustain a §102(b) rejection with respect to claim 1 and its dependent claims, Taylor must contain all of the above elements of claim 1. However, Taylor does not disclose an impactee having a second down-hole tool connector and a plurality of flexible coupling fingers positionally fixed relative to the second down-hole tool connector in an axial direction, in the context of claim 1. In contrast, Taylor

discloses a radially expandable lug array which is movable in an axial direction relative to the second down-hole connector, in the context of claim 1.

Therefore, Taylor fails to teach every element of claim 1, such that the §102(b) rejection of claim 1 and its dependent claims cannot be supported by Taylor. Accordingly, Applicants respectfully request the Examiner withdraw the §102(b) rejection of claim 1 and its dependent claims 2, 4, 7-10, 19-24, 27, 28, and 30-32.

Claim 33

Claim 33 recites:

33. An impact jar for use in a cased well-bore, comprising:  
first and second opposing cased well-bore tool connectors;  
an impactor coupled to the first cased well-bore tool connector; and  
an impactee slidably coupled to the impactor, the impactor and the  
impactee configured to impact when a tensile force applied across the first  
and second cased well-bore connectors reaches a field adjustable  
predetermined quantity, wherein the field adjustable predetermined  
quantity is adjustable over a substantially continuous range of tensile  
force quantities.

To sustain a §102(b) rejection of claim 33 and its dependent claims, Taylor must contain all of the above elements of claim 33. However, Taylor does not disclose an impactor and impactee configured to impact when a tensile force applied across first and second cased well-bore connectors reaches a field adjustable predetermined quantity, wherein the field adjustable predetermined quantity is adjustable over a substantially continuous range of tensile force quantities, in the context of claim 33. That is, Taylor discloses a configuration in which the “triggering” tensile force is incrementally adjustable over a range of tensile force quantities, but the “triggering” tensile force is not substantially continuously adjustable of the range of tensile force quantities.

Therefore, Taylor fails to teach every element of claim 33, such that the §102(b) rejection of claim 33 and its dependent claims cannot be supported by Taylor. Accordingly, Applicants respectfully request the Examiner withdraw the §102(b) rejection of claim 33 and its dependent claim 35.

Claim 36

Claim 36 recites:

36. A method of dislodging down-hole equipment from a well-bore, comprising:  
coupling an impact jar to the down-hole equipment, the impact jar including:  
an impactor coupled to a tensioning device;  
an impactee slidably coupled to the impactor and coupled to the down-hole equipment; and  
a biasable member detachably engaged to the impactee in a pre-impact position and configured to disengage the impactee in response to a tensile force applied by the tensioning device reaching a predetermined quantity, wherein the predetermined quantity is field-adjustable over a substantially continuous range of tensile force quantities, and wherein the impactor and impactee are configured to impact in response to the disengagement of the biasable member and the impactee;  
operating the tensioning device to increase the tensile force towards the predetermined quantity; and  
reducing the tensile force applied by the tensioning device after the biasable member and the impactee disengage.

To sustain a §102(b) rejection of claim 36 and its dependent claims, Taylor must contain all of the above elements of claim 36. However, Taylor does not disclose coupling an impact jar to down-hole equipment, the impact jar including a biasable member detachably engaged to an impactee in a pre-impact position and configured to disengage the impactee in response to a tensile force applied by a tensioning device reaching a predetermined quantity, wherein the predetermined quantity is field-adjustable over a substantially continuous range of tensile force quantities, in the context of claim 36. That is, Taylor discloses a configuration in which the “triggering” tensile force is incrementally adjustable over a range of tensile force quantities, but the “triggering” tensile force is not substantially continuously adjustable of the range of tensile force quantities.

Therefore, Taylor fails to teach every element of claim 36, such that the §102(b) rejection of claim 36 and its dependent claims cannot be supported by Taylor. Accordingly, Applicants respectfully request the Examiner withdraw the §102(b) rejection of claim 36 and its dependent claims 37-39, 41, 43, 44, 46, 47, and 49-51.

Claim 53

Claim 53 recites:

53. A wellbore system, comprising:  
a working string assembly including first and second portions;  
a tensioning device configured to apply an adjustable tensile force to the  
working string assembly; and  
an impact jar, including:  
an impactor coupled to the first working string assembly portion;  
an impactee coupled to the second working string assembly portion,  
slidably coupled to the impactor, and having a plurality of flexible  
coupling fingers positionally fixed relative to the second working string  
assembly portion in an axial direction; and  
a biasable member detachably engaged to the plurality of flexible  
coupling fingers in a pre-impact position and configured to disengage the  
plurality of flexible coupling fingers in response to a tensile force applied  
by the tensioning device reaching a predetermined quantity, wherein the  
impactor and impactee are configured to impact in response to the  
disengagement of the biasable member and the plurality of flexible  
coupling fingers.

To sustain a §102(b) rejection with respect to claim 53 and its dependent claims, Taylor must contain all of the above elements of claim 53. However, Taylor does not disclose an impact jar including an impactee having a plurality of flexible coupling fingers positionally fixed relative to a second working string assembly portion in an axial direction, in the context of claim 53. In contrast, Taylor discloses a radially expandable lug array which is movable in an axial direction relative to the second down-hole connector, in the context of claim 53.

Therefore, Taylor fails to teach every element of claim 53, such that the §102(b) rejection of claim 53 and its dependent claims cannot be supported by Taylor. Accordingly, Applicants respectfully request the Examiner withdraw the §102(b) rejection of claim 53 and its dependent claims 55 and 57.

**Rejections Under 35 U.S.C. §103(a)**

**Claims 3, 5, 6, 25, 26, and 29**

Claims 3, 5, 6, 25, 26, and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor. Applicants traverse this rejection on the grounds that Taylor is defective in establishing a *prima facie* case of obviousness with respect to claim 1 and, therefore, its dependent claims 3, 5, 6, 25, 26, and 29.

As the PTO recognizes in MPEP § 2142:

*... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following mutually exclusive reasons.

**1. Taylor does not teach the claimed subject matter**

As provided in 35 U.S.C. §103:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as described above, Taylor does not teach an impactee having a second down-hole tool connector and a plurality of flexible coupling fingers positionally fixed relative to the second down-hole tool connector in an axial direction, in the context of claim 1. Therefore, because Taylor does not teach all limitations of claim 1, and since claims 3, 5, 6, 25, 26, and 29 depend from and further limit claim 1, it is impossible for Taylor to render obvious the subject matter of any of claims 3, 5, 6, 25, 26, and 29, as a whole, and the explicit terms of §103(a) cannot be met.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by Taylor with respect to claims 3, 5, 6, 25, 26, and 29. Accordingly, Applicants respectfully request the Examiner withdraw the §103(a) rejection of claims 3, 5, 6, 25, 26, and 29.

## 2. The extension of Taylor is improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is another mutually exclusive and compelling reason why Taylor, if modified as suggested by the Examiner, cannot be applied to reject claim 1 and, therefore, its dependent claims 3, 5, 6, 25, 26, and 29 under 35 U.S.C. §103(a).

The MPEP provides in §2142 that:

*...the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, Taylor fails to teach or even suggest the modification suggested by the Examiner since, as described above, Taylor fails to teach an impactee having a second down-hole tool connector and a plurality of flexible coupling fingers positionally fixed relative to the second down-hole tool connector in an axial direction, in the context of claim 1. Thus, it is clear that Taylor provides no incentive or motivation for the modifications suggested by the Examiner. Therefore, there is simply no basis in the art for modifying Taylor to support a 35 U.S.C. §103(a) rejection of claim 1 and its dependent claims 3, 5, 6, 25, 26, and 29.

In this context, the MPEP further provides at §2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by modifications of prior art references in the absence of some teaching, suggestion or incentive supporting

such modification to produce the claimed invention. In the present case, it is clear that the Examiner's modification can arise solely from hindsight based on the invention, as there exists no showing, suggestion, incentive, or motivation in Taylor to arrive at the Examiner's suggested modifications as applied to claims 3, 5, 6, 25, 26, and 29.

Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by Taylor with respect to claim 1 and its dependent claims 3, 5, 6, 25, 26, and 29. Accordingly, Applicants respectfully request the Examiner withdraw the §103(a) rejection of claims 3, 5, 6, 25, 26, and 29.

#### Claims 40, 42, 45, and 52

Claims 40, 42, 45, and 52 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor. Applicants traverse this rejection on the grounds that Taylor is defective in establishing a *prima facie* case of obviousness with respect to claim 36 and, therefore, its dependent claims 40, 42, 45, and 52, for the following mutually exclusive reasons.

##### **1. Taylor does not teach the claimed subject matter**

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as described above, Taylor does not teach coupling an impact jar to down-hole equipment, the impact jar including a biasable member detachably engaged to an impactee in a pre-impact position and configured to disengage the impactee in response to a tensile force applied by a tensioning device reaching a predetermined quantity, wherein the predetermined quantity is field-adjustable over a substantially continuous range of tensile force quantities, in the context of claim 36. Therefore, because Taylor does not teach all limitations of claim 36, and since claims 40, 42, 45, and 52 depend from and further limit claim 36, it is impossible for Taylor to render obvious the subject matter of any of claims 40, 42, 45, and 52, as a whole, and the explicit terms of §103(a) cannot be met.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by Taylor with respect to claims 40, 42, 45, and 52. Accordingly, Applicants respectfully request the Examiner withdraw the §103(a) rejection of claims 40, 42, 45, and 52.

**2. The extension of Taylor is improper**

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is another mutually exclusive and compelling reason why Taylor, if modified as suggested by the Examiner, cannot be applied to reject claim 36 and, therefore, its dependent claims 40, 42, 45, and 52 under 35 U.S.C. §103(a). That is, Taylor fails to teach or even suggest the modification suggested by the Examiner since, as described above, Taylor fails to teach coupling an impact jar to down-hole equipment, the impact jar including a biasable member detachably engaged to an impactee in a pre-impact position and configured to disengage the impactee in response to a tensile force applied by a tensioning device reaching a predetermined quantity, wherein the predetermined quantity is field-adjustable over a substantially continuous range of tensile force quantities, in the context of claim 36.

Thus, it is clear that Taylor provides no incentive or motivation for the modifications suggested by the Examiner. Therefore, there is simply no basis in the art for modifying Taylor to support a 35 U.S.C. §103(a) rejection of claim 36 and its dependent claims 40, 42, 45, and 52.

In this context, the courts have repeatedly held that obviousness cannot be established by modifications of prior art references in the absence of some teaching, suggestion or incentive supporting such modification to produce the claimed invention. In the present case, it is clear that the Examiner's modification can arise solely from hindsight based on the invention, as there exists no showing, suggestion, incentive, or motivation in Taylor to arrive at the Examiner's suggested modifications as applied to claims 40, 42, 45, and 52.

Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by Taylor with respect to claim 36 and its dependent claims 40, 42, 45, and 52. Accordingly, Applicants respectfully request the Examiner withdraw the §103(a) rejection of claims 40, 42, 45, and 52.

**Claims 54 and 56**

Claims 54 and 56 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor. Applicants traverse this rejection on the grounds that Taylor is defective in establishing a *prima facie* case of obviousness with respect to claim 53 and, therefore, its dependent claims 54 and 56, for the following mutually exclusive reasons.

**1. Taylor does not teach the claimed subject matter**

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as described above, Taylor does not teach an impact jar including an impactee having a plurality of flexible coupling fingers positionally fixed relative to a second working string assembly portion in an axial direction, in the context of claim 53. Therefore, because Taylor does not teach all limitations of claim 53, and since claims 54 and 56 depend from and further limit claim 53, it is impossible for Taylor to render obvious the subject matter of either of claims 54 or 56, as a whole, and the explicit terms of §103(a) cannot be met.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by Taylor with respect to claims 54 and 56. Accordingly, Applicants respectfully request the Examiner withdraw the §103(a) rejection of claims 54 and 56.

**2. The extension of Taylor is improper**

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is another mutually exclusive and compelling reason why Taylor, if modified as suggested by the Examiner, cannot be applied to reject claim 53 and, therefore, its dependent claims 54 and 56 under 35 U.S.C. §103(a). That is, Taylor fails to teach or even suggest the modification suggested by the Examiner since, as described above, Taylor fails to teach an impact jar including an impactee having a plurality of flexible coupling fingers positionally fixed relative to a second working string assembly portion in an axial direction, in the context of claim 53.

Thus, it is clear that Taylor provides no incentive or motivation for the modifications suggested by the Examiner. Therefore, there is simply no basis in the art for modifying Taylor to support a 35 U.S.C. §103(a) rejection of claim 53 and its dependent claims 54 and 56.

In this context, the courts have repeatedly held that obviousness cannot be established by modifications of prior art references in the absence of some teaching, suggestion or incentive supporting such modification to produce the claimed invention. In the present case, it is clear that the Examiner's modification can arise solely from hindsight based on the invention, as there exists no showing, suggestion, incentive, or motivation in Taylor to arrive at the Examiner's suggested modifications as applied to claims 54 and 56.

Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by Taylor with respect to claim 53 and its dependent claims 54 and 56. Accordingly, Applicants respectfully request the Examiner withdraw the §103(a) rejection of claims 54 and 56.

Claims 11-18

Claims 11-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor in view of U.S. Patent No. 3,685,598 to Nutter ("Nutter"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1 and, therefore, its dependent claims 11-18 for the following mutually exclusive reasons.

**1. Even when combined, the references do not teach the claimed subject matter**

As discussed above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as also described above, Taylor fails to teach all of the limitations of claim 1. Moreover, Nutter fails to cure this shortcoming of Taylor. That is, as with Taylor, Nutter fails to teach an impactee having a second down-hole tool connector and a plurality of flexible coupling fingers positionally fixed relative to the second down-hole tool connector in an axial direction, in the context of claim 1. In contrast, Nutter teaches a sleeve member 35 that is longitudinally movable relative to the mandrel 21, wherein the mandrel 21 includes the second down-hole tool connector (portion 23) in the context of claim 1.

Thus, the combination of Taylor and Nutter fails to teach all limitations of claim 1. Moreover, since claims 11-18 depend from and further limit claim 1, it is impossible for the combination of Taylor and Nutter to render obvious the subject matter of claims 11-18, as a whole, and the explicit terms of §103(a) cannot be met.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Taylor and Nutter with respect to claims 11-18. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of claims 11-18 under 35 U.S.C. §103(a).

**2. The combination of references is improper**

Assuming, arguendo, that the above arguments for non-obviousness do not apply (which is clearly not the case based on the above), there is another mutually exclusive and compelling reason why the combination of Taylor and Nutter cannot be applied to reject claim 1 and its dependent claims 11-18 under 35 U.S.C. §103. That is, neither Taylor nor Nutter teaches, or even suggests, the desirability of the combination since neither teaches an impactee having a second down-hole tool connector and a plurality of flexible coupling fingers positionally fixed relative to the second down-hole tool connector in an axial direction, in the context of claim 1.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 1 or its dependent claims 11-18.

In this context, the MPEP further provides at §2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination of Taylor and Nutter can arise solely from hindsight based on the present disclosure, and without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1 or its dependent claims 11-18. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Taylor and Nutter with respect to claims 11-18. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of claims 11-18 under 35 U.S.C. §103(a).

Claim 34

Claim 34 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor in view of Nutter. Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 33 and, therefore, its dependent claim 34 for the following mutually exclusive reasons.

**1. Even when combined, the references do not teach the claimed subject matter**

As discussed above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as also described above, Taylor fails to teach all of the limitations of claim 33. Moreover, Nutter fails to cure this shortcoming of Taylor. That is, as with Taylor, Nutter fails to teach an impactor and impactee configured to impact when a tensile force applied across first and second cased well-bore connectors reaches a field adjustable predetermined quantity, wherein the field adjustable predetermined quantity is adjustable over a substantially continuous range of tensile force quantities, in the context of claim 33. In fact, Nutter fails to teach that the “triggering” tensile force adjustable in any manner, whatsoever.

Thus, the combination of Taylor and Nutter fails to teach all limitations of claim 33. Moreover, since claim 34 depends from and further limits claim 33, it is impossible for the combination of Taylor and Nutter to render obvious the subject matter of claim 34, as a whole, and the explicit terms of §103(a) cannot be met.

Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Taylor and Nutter with respect to claim 34. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of claim 34 under 35 U.S.C. §103(a).

**2. The combination of references is improper**

Assuming, arguendo, that the above arguments for non-obviousness do not apply (which is clearly not the case based on the above), there is another mutually exclusive and compelling reason why the combination of Taylor and Nutter cannot be applied to reject claim 33 and its dependent claim 34 under 35 U.S.C. §103. That is, neither Taylor nor Nutter teaches, or even suggests, the desirability of the combination since neither teaches an impactor and impactee configured to impact when a tensile force

applied across first and second cased well-bore connectors reaches a field adjustable predetermined quantity, wherein the field adjustable predetermined quantity is adjustable over a substantially continuous range of tensile force quantities, in the context of claim 33.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 33 or its dependent claim 34.

In this context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination of Taylor and Nutter can arise solely from hindsight based on the present disclosure, and without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 33 or its dependent claim 34. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Taylor and Nutter with respect to claim 34. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of claim 34 under 35 U.S.C. §103(a).

#### Claim 48

Claim 48 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor in view of Nutter. Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 36 and, therefore, its dependent claim 48 for the following mutually exclusive reasons.

##### **1. Even when combined, the references do not teach the claimed subject matter**

As discussed above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as also described above, Taylor fails to teach all of the limitations of claim 36. Moreover, Nutter fails to cure this shortcoming of Taylor. That is, as with Taylor, Nutter fails to teach coupling an impact jar to down-hole equipment, the impact jar including a biasable member detachably engaged to an impactee in a pre-impact position and configured to disengage the impactee in response to a tensile force applied by a tensioning device reaching a predetermined quantity, wherein the predetermined quantity is field-adjustable over a substantially continuous range of tensile force quantities,

in the context of claim 36. In fact, Nutter fails to teach that the “triggering” tensile force adjustable in any manner, whatsoever.

Thus, the combination of Taylor and Nutter fails to teach all limitations of claim 36. Moreover, since claim 48 depends from and further limits claim 36, it is impossible for the combination of Taylor and Nutter to render obvious the subject matter of claim 48, as a whole, and the explicit terms of §103(a) cannot be met.

Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Taylor and Nutter with respect to claim 48. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of claim 48 under 35 U.S.C. §103(a).

## **2. The combination of references is improper**

Assuming, arguendo, that the above arguments for non-obviousness do not apply (which is clearly not the case based on the above), there is another mutually exclusive and compelling reason why the combination of Taylor and Nutter cannot be applied to reject claim 36 and its dependent claim 48 under 35 U.S.C. §103. That is, neither Taylor nor Nutter teaches, or even suggests, the desirability of the combination since neither teaches coupling an impact jar to down-hole equipment, the impact jar including a biasable member detachably engaged to an impactee in a pre-impact position and configured to disengage the impactee in response to a tensile force applied by a tensioning device reaching a predetermined quantity, wherein the predetermined quantity is field-adjustable over a substantially continuous range of tensile force quantities, in the context of claim 36.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 36 or its dependent claim 48.

In this context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner’s combination of Taylor and Nutter can arise solely from hindsight based on the present disclosure, and without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 36 or its dependent claim 48. Therefore, for this mutually exclusive reason, the Examiner’s burden of factually

supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Taylor and Nutter with respect to claim 48. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of claim 48 under 35 U.S.C. §103(a).

**Conclusion**

It is believed that all matters set forth in the Office Action have been addressed, and that claims 1-57 are in condition for allowance. Favorable consideration and an early indication of the allowability of the claims are respectfully requested. Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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Dated: 10/21/05

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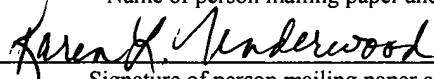
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DATE OF DEPOSIT: October 21, 2005

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Karen L. Underwood

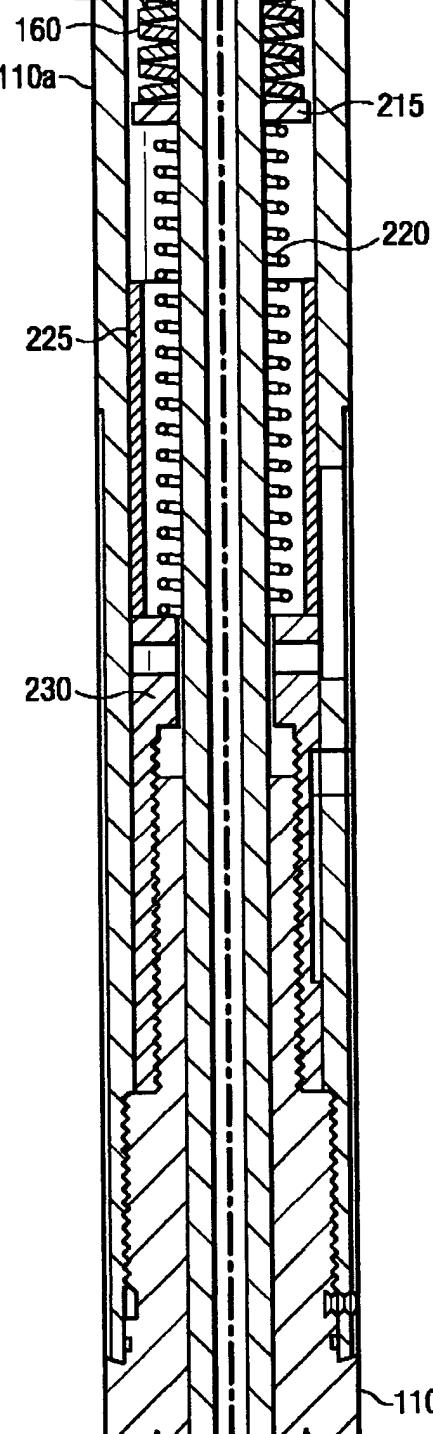
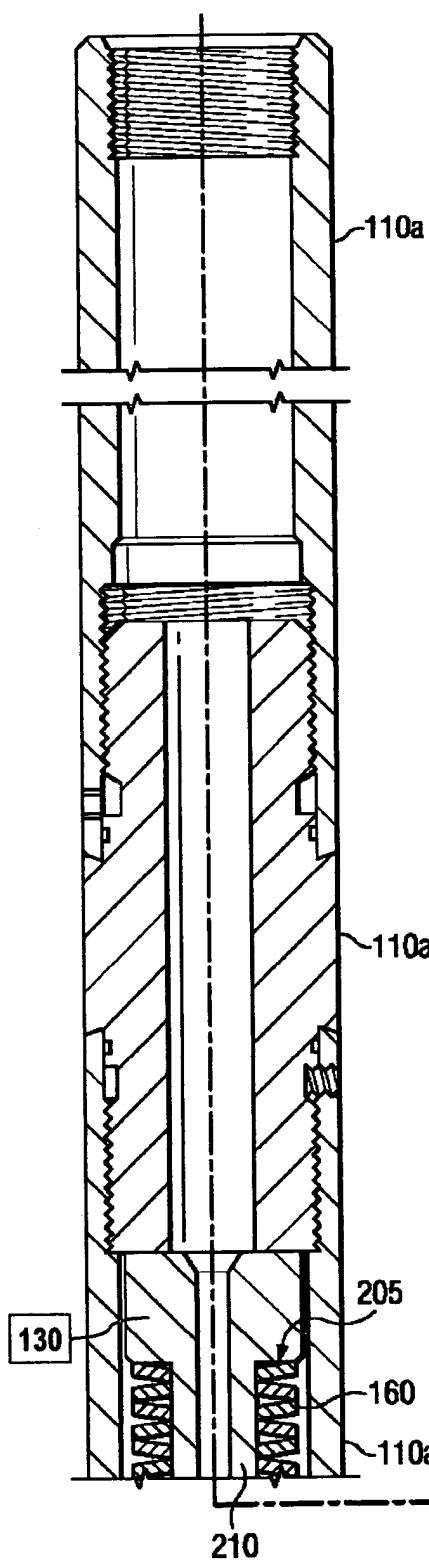
Name of person mailing paper and fee



Signature of person mailing paper and fee

2/9

Fig. 2A



5/9

Fig. 4

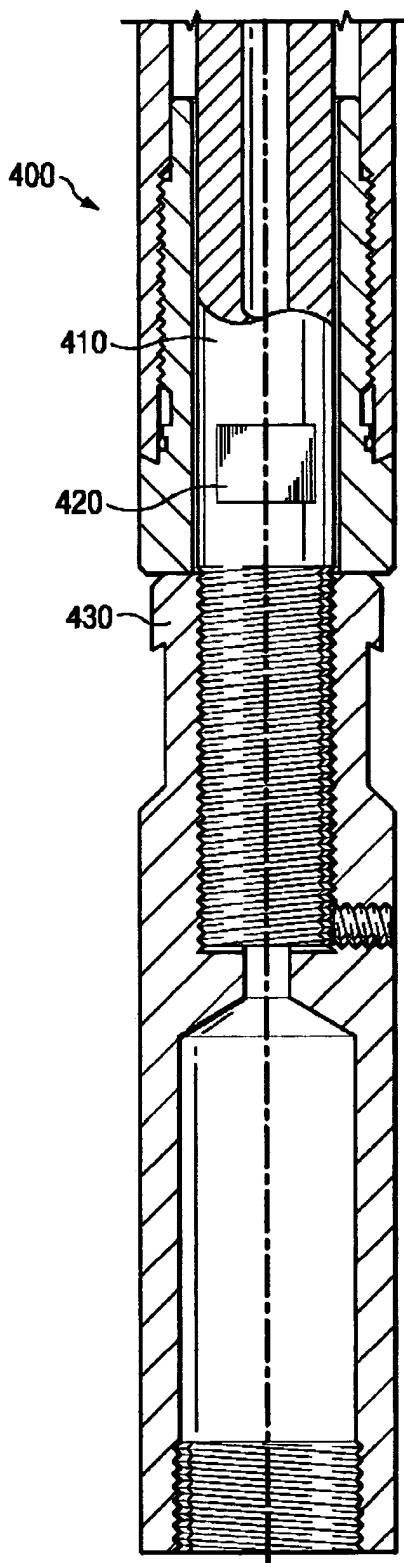
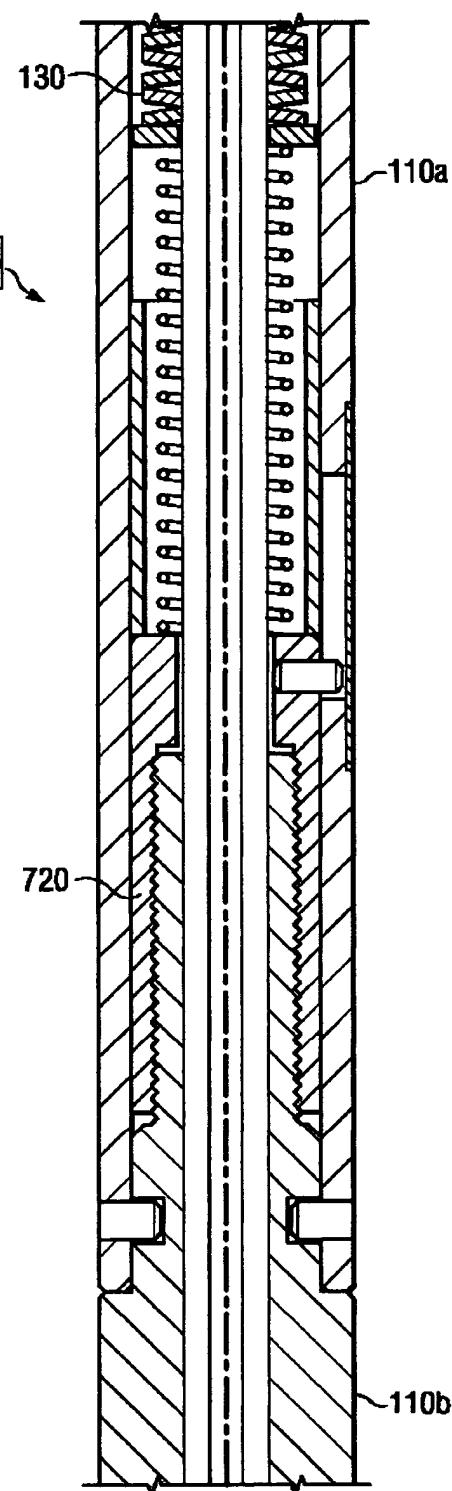
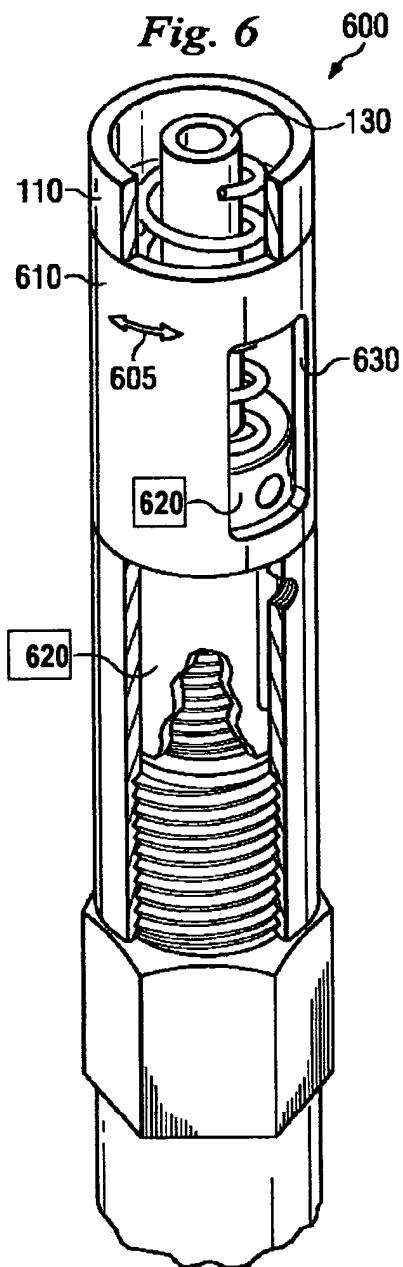


Fig. 7



8/9

*Fig. 6**Fig. 8*